

## **REMARKS**

In the Office Action<sup>1</sup>, the Examiner:

made a Requirement for Information under 37 C.F.R. § 1.105;

objected to claims 1, 6-8, 11, and 12;

rejected claims 1-12 under 35 U.S.C. § 101; and

rejected claims 1-13 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent Application Publication 2009/0024997 to Kobayashi ("Kobayashi") in view of "Reducing parts diversity in product design: a data centered approach" by Chochon et al. ("Chochon").

By this Amendment, Applicants amend claims 1, 6-8, and 10-13, and cancel claims 2 and 9 without prejudice or disclaimer. Claims 1, 3-8, and 10-13 remain pending.

### **I. The Requirement for Information under 37 CFR 1.105**

The Office issued a Requirement for Information ("Requirement") under 37 C.F.R. § 1.105, requesting certain documents that the Office alleges are informally cited in the Applicants' specification. See Office Action at 2. Specifically, the Office requests copies of the ISO 13584/PLIB standard, IEC 61306, ISO 6523 "Structure for Identification of Organizations and Organization Parts," and certified English translations of "foreign priority document" JP 2004-177996 and 2004-178015. See id.

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<sup>1</sup> The Office Action may contain statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

#### **A. ISO 13584/PLIB standard**

In response to the request for documents pertaining to the ISO 13584/PLIB standard, Applicants submit the following documents:

- Part 1: Overview and fundamental principles
- Part 10: Conceptual Model of Parts Library
- Part 20: Logical model of expressions
- Part 24: Logical resource: Logical model of supplier library
- Part 25: Logical resources: Logical model of supplier library with aggregate values and explicit content
- Part 26: Logical resource: Information supplier identification
- Part 32: Implementation resources: OntoML: Ontology markup language
- Part 35: Spreadsheet interface for parts library - Representation structure
- Part 42: Methodology for structuring part families
- Part 501: Reference dictionary for measuring instruments - Registration procedure
- Part 511: Mechanical systems and components for general use - Reference dictionary for fasteners
- PLIBEditor Manual

#### **B. IEC 61360**

With regard to the Office's request for documents pertaining to IEC 61360, Applicants note that the specification makes reference to only IEC 61360-2 (Part 2 of the standard). Accordingly, Applicants presume that the Office requests only this part of

the standard, as a request for the entire standard is unduly burdensome and the Office has provided no justification for requiring copies of the entire international standard.

Accordingly, Applicants submit the following document for compliance with the Requirement:

- Part 2: EXPRESS dictionary schema

#### **C. ISO 6523**

In response to the Office's request for documents pertaining to ISO 6523 "Structure for Identification of Organizations and Organization Parts," Applicants submit the following document:

- Data Interchange - Structure for the identification or organizations

#### **D. JP 2004-177996 and JP 2004-178015**

In response to the Office's request for certified translations of JP 2004-177996 and JP 2004-178015, Applicants note that JP 2004-177996 and JP 2004-178015 are not "foreign priority documents" as alleged by the Office. See Office Action at 2. The instant application does not claim priority to either of the documents. Furthermore, the undersigned has been advised by Japanese foreign counsel that certified English translations of these documents are not readily available. "Any reply to a requirement for information pursuant to this section that states either that the information required to be submitted is unknown to or is not readily available to the party or parties from which it was requested may be accepted as a complete reply." 37 C.F.R. § 1.105(a)(4).

As the certified English translations are not readily available, Applicants hereby provide copies of the specifications of U.S. Patent Application Nos. 10/717,561 (corresponding to JP 2004-177996) and 10/717,707 (corresponding to JP 2004-178015).

JP 2004-177996 is a Japanese publication of Japanese Patent Application 2002-339929, and U.S. Patent Application 10/717,561 is based upon Japanese Patent Application 2002-339929, as noted on page 1 of the '561 specification.

Likewise, JP 2004-178015 is a Japanese publication of Japanese Patent Application 2002-340041, and U.S. Patent Application 10/717,707 is based upon Japanese Patent Application 2002-240041, as noted on page 1 of the '707 specification.

#### **E. Information Disclosure Statement**

Additionally, Applicants file concurrently herewith an Information Disclosure Statement citing the above documents provided in response to the Requirement. This Reply to the Rule 1.105 requirement does not represent that no better art exists or that a search has been made, and does not constitute an admission that each or all of the listed documents are material or constitute "prior art." Applicants respectfully request that all of the references cited in the Information Disclosure Statements submitted to the Office be considered and not just the references listed above.

Finally, Applicants' response is not an admission that the requirement for information is proper. Rather, Applicants submit the above information solely in an attempt to comply with the requirements for reply and to demonstrate a good faith effort to obtain the requested factual information. See MPEP §§ 704.12 and 704.12(b).

Accordingly, Applicants reserve the right to petition to have the requirement withdrawn or modified under 37 C.F.R. § 1.181. See MPEP § 704.14(c).

**II. The Objection to Claims 1, 6-8, 11, and 12**

Applicants have amended claims 1, 6-8, 11, and 12 in accordance with the Office's recommendations. Accordingly, Applicants respectfully request the Examiner withdraw the objection to claims 1, 6-8, 11, and 12.

**III. The Rejection of Claims 1 and 9 under 35 U.S.C. § 101**

Applicants respectfully traverse the rejection of claims 1-12 under 35 U.S.C. § 101. Independent claim 1 has been amended to recite a processor, and therefore the apparatus is disclosed to recite hardware elements and is tied to a particular machine, and falls within one of the recognized classes of statutory subject matter. As amended independent claim 1 is statutory subject matter, dependent claims 2-12 are also statutory at least due to their dependence. Accordingly, Applicants respectfully request the Examiner withdraw the rejection.

**IV. The Rejection of Claims 1-13 Under 35 U.S.C. § 103(a)**

Applicants respectfully traverse the rejection of claims 2 and 6-13 under 35 U.S.C. § 103(a) as being unpatentable over Kobayashi in view of Chochon. Applicants submit that Kobayashi is not valid prior art against Applicants' application, and therefore the rejection under § 103(a) is improper and must be withdrawn.

Applicants submit that the Office's reliance on Kobayashi as prior art is misplaced. For art to be relied upon under 35 U.S.C. § 103(a) as the basis for an obviousness rejection, the art must first qualify as prior art under the definition of 35 U.S.C. § 102.

Kobayashi is a publication of an application which is a § 371 National Stage application off of international application PCT/JP03/14646, filed November 18, 2003. PCT/JP03/14646, however, was **not** published in English, and accordingly, Kobayashi is only available as prior art based on the date of the publication of Kobayashi, which is January 22, 2009.

If the international application was filed on or after November 29, 2000, but did **not** designate the United States or was **not** published in English under PCT Article 21(2), do **not** treat the international filing date as a U.S. filing date. In this situation, do not apply the reference as of its international filing date, its date of completion of the 35 U.S.C. 371(c)(1), (2) and (4) requirements, or any earlier filing date to which such an international application claims benefit or priority. The reference may be applied under 35 U.S.C. 102(a) or (b) as of its publication date, or 35 U.S.C. 102(e) as of any later U.S. filing date of an application that properly claimed the benefit of the international application (if applicable).

MPEP 2136.03(II)(B) (emphases in original). See also MPEP 2136.03(II)(A). As noted above, PCT/JP03/14646 was not published in English, and the Office therefore cannot apply Kobayashi as of the international filing date, its date of completion of the § 371 requirement, or any earlier filing date to which such an international application claims benefit or priority. Accordingly, Kobayashi may only be applied as of its publication date under §§ 102(a) or (b).

In contrast, Applicants' application is a § 371 National Stage application, and has an effective filing date of March 2, 2006, the international filing date of international

application PCT/JP2006/004524. See MPEP 1893.03(b). As Kobayashi is only valid prior art as of its publication date of January 22, 2009, Applicants' effective filing date predates Kobayashi. Accordingly, Kobayashi is not available as prior art, because the present application has a filing date that predates Kobayashi. Because Kobayashi is not available as prior art in a § 103(a) rejection of the instant application, Applicants respectfully submit that the Office cannot rely upon it to support the pending § 103 rejection. Accordingly, the rejection is improper and Applicants respectfully request that the Office withdraw this rejection.

Furthermore, should the Office issue a subsequent Office Action, Applicants note that the Office Action must be non-final, as to date the Office has not provided a valid rejection of Applicants' application, due to the rejection in view of Kobayashi being invalid and improper. Furthermore, any new ground of rejection would not have been necessitated by Applicants' amendments, as the new ground of rejection would only be necessitated by the improper reliance on Kobayashi.

**V. Conclusion**


In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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Dated: January 15, 2010

By:   
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